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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/867,594	05/29/2001	David W. Boreham	P5836	6565
7590	03/24/2004		EXAMINER	
WAGNER, MURABITO & HAO LLP Two N. Market st. Third Floor San Jose, CA 95113			LU, KUEN S	
			ART UNIT	PAPER NUMBER
			2177	(0)
DATE MAILED: 03/24/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/867,594	BOREHAM ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Kuen S Lu	2177	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 February 2004.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-15 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

## ***DETAILED ACTION***

### ***Drawings***

1. The drawings filed on 5/29/2001 are not approved by the Draftsperson under 37 CFR 1.84 or 1.152, formal drawings are required in response to this office action, Figures 1-24. The drawings are objected to as failing to comply with 37 CFR 1.84(p) because Figure legends are poor. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

2. Claims 14-16 are objected to because of the following informalities: The claims are dependent on an apparatus claim 13, however, each of the claims 14-16 starts with the phrase "The method as in claim 13.". The terms "method" in the claims 14-16 are inconsistent with the term "apparatus" in claim 13. Appropriate correction is required.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

3. Claims 5 and 6 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 6 and 7, respectively, of copending Application No.

09/867595. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1,7,9,13 and 14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1,8,10,15 and 17, respectively, of copending application No. 09/867595. Although the conflicting claims are not identical, they are not patentably distinct from each other.

Claim 1 of instant invention substantially recites the limitation of claim 1 of 09/867595. The distinction between the two claims is that the definition entry of the instant invention includes specifier attribute for target entry while the 09/867595 application includes one or more template entries. It would have been obvious to one of ordinary skill in the art of directory data repository to create the definition entry comprising of target and template entries through the association of attributes or DN value of the entries because it would allow the sharing of attributes and the ordinary artisan would create a CoS scheme comprising of both definition and template entries.

Claim 7 of instant invention and claim 8 of 09/867595 application are both directed to a method for determining if a CoS specifier associated with a matched attribute-value pair matches a CoS entry. The 09/867595 application determines the match of CoS

specifier against the destined entry obtained through the association of attribute-value pair, while the instant invention matches CoS specifier against the valid second target entry. It would have been obvious to one of ordinary skill in the art of directory data repository to determine the match through searching directly to the second target entry or by association of attribute-pair because it would search through the definition, target and template entry schemes and it would allow the ordinary artisan to retrieve the

Claim 9 of instant invention and claim 10 of 09/867595 application are both directed to an apparatus component for creating CoS scheme comprising of a definition entry where the 09/867595 application further includes a specifier and a list of attributes in the definition entry while the instant invention does not have such a limitation, however, further extends directory CoS with one or more template entries. It would have been obvious to one of ordinary skill in the art of directory server to create CoS scheme to broadly include specifier and other attributes in the definition entry and further extend the association of attributes to other entries, such as target or template, because it would allow the ordinary artisan to create a complete definition of CoS scheme and thoroughly retrieve the directory.

Claim 13 of instant invention and claim 15 of 09/867595 are both directed to an apparatus component to configure an attribute-value pair that could be shared by target entries. The instant invention limits the entries to using an indirect CoS scheme while the application 09/867595 does not have such a limitation. It would have been obvious to one of ordinary skill in the art of directory server to configure the attribute-value pair of directory server entry without such limitation, because it would allow the ordinary artisan

to have flexibility for creating the pair for any type of entry schemes, for example, indirect, classic, pointer or template.

Claim 14 of the instant invention and claim 17 of 09/867595 are both directed to configure an apparatus component for applying a set of constraints on a list of matched attribute-value pairs. The 09/867595 application determines the match of CoS specifier against the destined entry obtained through the specifier attribute of definition entry, while the instant invention matches CoS specifier against the valid second target entry. It would have been obvious to one of ordinary skill in the art of directory data repository to determine the match through both methods because it would search through the definition, target and template entries of various schemes and it would allow the ordinary artisan to retrieve the directory data more complete and efficiently.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claims 1-16 are rejected under 35 U.S.C. 102(a) as anticipated by iPlanet Directory Server Administrator's Guide (Version 5.0, April 2001, Sun Microsystems, Inc., hereafter iPlanet).

As per claims 1 and 9, iPlanet teaches the following:

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"a method configuring a directory server comprising a plurality of entries" at Page 19, Para. "Introduction", lines 1-2 by implementing iPlanet as a LDAP protocol based directory server, and at Page 37, Para. "Managing Entries..." by creating a root entry and directory entries;

"creating a CoS scheme," at Page 171, Section "Creating a new CoS" steps 1 through 8, and "wherein the CoS scheme comprises a CoS Definition entry" at Page 170 diagram by showing the CoS definition entry of (cn=IndirectCos, dc=siroe, dc=com), "which includes a CoS specifier and a list of attributes" by showing attributes cosIndirectSpecifier and cosAttribute, and "where a first target entry within scope of CoS scheme obtains values for attributes provided in the CoS definition entry by using an attribute with a distinguishing name (DN) value contained within the first target entry" by showing the values 'manager' and 'departmentNumber' for attributes osIndirectSpecifier and cosAttribute in the definition entry obtained from distinguishing name manager in the Target Entry of (cn=wholiday...).

As per claims 2 and 10, iPlanet teaches "DN points to a second target entry which is a valid entry" at Page 170 diagram by showing manager attribute in the target entry pointing to the DN entry (cn=Carla Fuentes...) in the Template Entry.

As per claims 3 and 11, iPlanet teaches "DN points to a second target entry which is a valid entry and the first entry uses the second target entry as a template" at Page 170 diagram as applied to Claim 2, and the entry (cn=wholiday...) uses entry (cn=Carla...) as a template.

As per claims 4 and 12, iPlanet teaches "the value of the CoS specifier in the CoS Definition entry appears in a target entry as a first attribute type" at Page 170 diagram by showing the value of attribute cosIndirectSpecifier, which is manager, as the first attribute type in the target entry.

As per claims 5 and 13, iPlanet teaches "attribute-value pair stored in a directory system and shared by a plurality of target entries in the directory system" at Page 170 diagram by showing the sharing of attribute-value pairs cosIndirectSpecifier-manager and cosAttribute-departmentNumber between target and definition entries; "creating an indirect CoS scheme" at Pages 171-173, steps 1 through 8; "receiving a request for an attribute-value pair associated with a first target entry" at Page 172, step 6; "searching in a list of attribute-value pairs which are associated with template entries that are in turn associated with CoS Definition entries for instances of attribute value pairs that match the requested attribute type, said searching step resulting in a matches list of attribute-value pairs" at Pages 172-173, step 7; "applying at least one of a set of constraints to the matched list of attribute-value pairs" at Page 172, step 7 by using the value of one of the target entry's attribute; and "returning the attribute-value pair that satisfied the applied constraint(s)" at Page 173 by using both its DN and the value of the target entry's attributes and step 8.

As per claims 6 and 14, iPlanet teaches "set of constraints includes CoS scope" at Page 173, lines 2-3 by showing one of the target entry's attributes, a classic CoS.

As per claims 7 and 15, iPlanet teaches “the set of constraints includes determining if a CoS specifier associated with the matched attribute-value pair matches a valid second target entry” at Page 169, section “How an Indirect CoS Works” by using manager attribute of the target entry to identify the template entry.

As per claims 8 and 16, iPlanet teaches “the matched second target entry contains an attribute provided in the indirect CoS scheme” at Page 170 by showing pointers of attribute departmentNumber in both template and target entries.

### The prior art made of record

6. A. iPlanet Directory Server Administrator's Guide, Version 5.0,  
Sun Microsystems, Inc. Doc. ID 816-0799-01, April, 2001.

## **Response to Arguments**

7. Applicants have submitted, February 2, 2004, a declaration under 37 C.F.R. 1.132 attempting to show that the iPlanet publication is applicants' invention.

The Examiner notes that the only statement addressing the issue is in paragraph number 3, which states "We conceived and invented the subject matter disclosed the above iPlanet reference".

This statement is inadequate to remove the reference as prior art. Applicants must (a) show, by way of evidence, that he or she made the invention upon which the relevant disclosure is based and (b) that the author of the publication derived his knowledge of the relevant subject matter from Applicant. (See MPEP 715.01(c), subsection entitled "DERIVATION")

No evidence is provided to support declarant's conclusory statement. Furthermore, declarant's statement can be read to merely mean that the iPlanet publication discloses what Applicants have independently invented. As the issue is not whether Applicants have independently invented but whether the reference is attributable to Applicants, the declaration is not effective.

8. In light of the forgoing arguments, the U.S.C 102 rejection for Claims 1-15 is hereby sustained.

### ***Conclusions***

**9. THIS ACTION IS MADE FINAL.**

The Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The prior art made of record, listed on form PTO-892, and not relied upon, if any, is considered pertinent to applicant's disclosure.

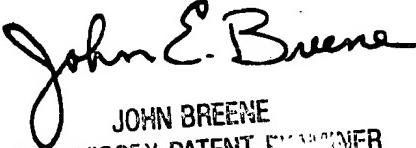
If a reference indicated as being mailed on PTO-FORM 892 has not been enclosed in this action, please contact Lisa Craney whose telephone number is (703) 305-9601 for faster service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuen S Lu whose telephone number is 703-305-4894. The examiner can normally be reached on 8 AM to 5 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Kuen S. Lu   
Patent Examiner  
March 10, 2004

  
JOHN BREENE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100